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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,550	02/09/2004	Andrew F. Hall	5236-000476/US	8958

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EXAMINER	
PEFFLEY, MICHAEL F	

ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/774,550	HALL ET AL.	
	Examiner	Art Unit	
	Michael Peffley	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6/9/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Specification

The disclosure is objected to because of the following informalities: the first sentence of the specification should be amended to provide the most current status (e.g. "now abandoned") for the related applications.

Appropriate correction is required.

Claim Objections

Claims 9 and 33 are objected to because of the following informalities: claim 9 lacks proper antecedent basis for "the magnetically navigable electrode catheter (line 9) and "the electrode" (line 14); claim 33 lacks proper antecedent basis for "the core element" (line 6). Appropriate correction is required.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 9-11 and 19-31 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-18 of prior U.S. Patent No. 6,385,472. This is a double patenting rejection.

Claims 9-11 of the instant application are identical to claims 1-3 of the patent; application claims 19 and 20 correspond to patented claims 9 and 10; application claims

21 and 22 correspond to patented claims 14 and 15; application claims 23-25 correspond to patented claims 4-6; applications claims 26-18 correspond to patented claims 16-18; and application claims 29-31 correspond to patented claims 11-13.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 and 12-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,385,472. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims recite the same basic magnetically navigable catheter member with only obvious variations. It is noted that claims 1-8 of the instant application are identical to the originally filed claims 1-8 in the parent applications and claim subject matter which would be covered by the patented claims since they are broader in nature. Claim 12 of the instant application has been amended

from the original claim 12 in the parent application to recite a fluid passage. It is deemed an obvious modification to provide a means to provide fluid to tissue as is generally well-known throughout the art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Bourne et al (5,911,720).

Bourne et al disclose a catheter device having a sheath (124) a sleeve (115) slidably mounted in the sheath an capable of telescoping from the sheath, an extension member (116) having proximal and distal ends slidably mounted within the sleeve. As seen in Figure 11, the distal end portion of the extension member is more flexible than the distal end of the sleeve. As addressed throughout the disclosure, the device includes multiple electrodes at the distal end of the extension members and uses multiple magnets (42,44) which are capable of being oriented by application of an externally applied magnetic field.

Claims 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Fleischman et al (5,545,193).

As seen in Figure 51, Fleischman et al disclose a telescoping device comprising an outer sheath (178) and an inner core (224-226) slidably disposed within the sheath. The distal end of the inner core member may be oriented independently of the outer sheath. The Fleischman et al disclosure fully addresses the steerable nature of the device and its method of use.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall et al (6,292,678) in view of the teaching of Fleischman et al ('193).

Hall et al disclose a magnetically navigable catheter having a tubular magnetic member (36) and a plurality of electrodes (38) thereon. The magnetic defines a passage in view of its tubular shape. Hall et al also disclose the use of plurality annular magnets (Figures 11-16). However, the Hall et al electrodes are disclosed as being pads on the surface of the device, and not annular electrodes that would provide a passage as now recited in claim 12.

Fleischman et al disclose an analogous steerable catheter for the treatment of tissue with RF energy. In particular, Fleischman et al teach that it is known to provide

such a catheter with a variety of types of electrodes for treating tissue, including annular electrodes such that the device could treat tissue on either side of the catheter and electrode pads (202 – Figures 42 and 45) to allow treatment with only one portion of the catheter.

To have provided the Hall et al device with annular electrodes to allow for treatment of tissue on any side of the device would have been an obvious modification for one of ordinary skill in the art in view of the teaching Fleischman et al. Such an annular electrode would inherently provide a passage through which a fluid could be passed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Howard, III (6,129,685) discloses a catheter device having electrodes and a magnet to assist in navigation of the device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Peffley
Primary Examiner
Art Unit 3739

mp
May 29, 2006